

REMARKS

Claims 1 and 3 through 6 are pending in this Application. Claim 1 has been amended by incorporating the limitations of claim 2 therein, and a formalistic issue addressed as observed by the Examiner. Claim 2 has been cancelled. The dependencies of claims 3 and 4 have been appropriately changed. Applicants submit that the present Amendment does not generate any new matter issue.

Telephonic Interview of December 2, 2004

Applicants express appreciation for Examiner Bernatz's courtesy and professionalism in conducting a telephonic interview on December 2, 2004. During that interview the rejections in the November 16, 2004 Office Action and the present Amendment were discussed. Examiner Bernatz agreed that the present Amendment would overcome the imposed rejections and place the Application in condition for allowance. For completeness, each of the objections imposed in the November 16, 2004 Office Action is addressed.

Claims 1, 7 and 8 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Zhang et al. in view of Shiroishi et al.

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claim 2 into claim 1, claim 2 not being subject to this rejection. Claims 7 and 8 have been cancelled.

Accordingly, withdrawal of the rejection of claims 1, 7 and 8 under 35 U.S.C. § 103 for obviousness predicated upon Zhang et al. in view of Shiroishi et al. is solicited.

Claim 2 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Zhang et al. in view of Shiroishi et al. and Yamashita et al.

This rejection is traversed.

Initially, Applicants will treat this rejection as though applied against claim 1, since the limitations of claim 2 have been incorporated into claim 1. Applicants submit that the requisite motivation to combine the three applied references to arrive at the claimed invention has not been factually established. Specifically, it is apparent that Zhang et al. require the first and second magnetic layers to be formed of a cobalt-chromium-based magnetic alloy. However, Shiroishi et al. require the first and second magnetic layers to have “components or composition different” as specifically disclosed in column 5, lines 1 through 4. Indeed, adverting to column 6 of Shiroishi et al., it is disclosed that the first magnetic layer is formed of a CoNi-based alloy, while the second magnetic layer is formed of a CoCr- or CoSm-based alloy. Given these diametrically opposed teachings, it cannot be said that one having ordinary skill in the art would have been realistically impelled to deviate from the teachings of Zhang et al. by forming the second magnetic layer of a different alloy and **reasonably expect to successfully obtain** the advantage disclosed by Zhang et al., bearing in mind that the first magnetic layer in the double-layer structure of Zhang et al. **seeds** the microstructure of the upper magnetic layer and determines the noise characteristics of the double layer film which is desired by Zhang et al. *Velander v. Gardner*, 348 F.3d 1359, 68 USPQ2d 1769 (Fed. Cir. 2003); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The additional reference to Yamashita et al. does not cure the above argued deficiencies in the attempted combination of Zhang et al. and Shiroishi et al. Simply put neither Shiroishi et al. nor Yamashita et al. would have led one having ordinary skill in the art to proceed **against** the teachings

of Zhang et al., let alone with a **reasonable expectation** of achieving the advantages sought by Zhang et al. *Velander v. Gardner, supra; In re Vaeck, supra.*

Applicants, therefore, submit that the imposed rejection of claim 2 (now claim 1) under 35 U.S.C. § 103 for obviousness predicated upon Zhang et al. in view of Shiroishi et al. and Yamashita et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 5 and 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Zhang et al. in view of Shiroishi et al. and Malhotra et al.

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating limitations of claim 2 into claim 1, claim 2 not being subject to a rejection based upon the combined disclosures of Zhang et al. and Shiroishi et al. The additional reference to Malhotra et al. does not address limitations previously in claim 2 which have been incorporated into claim 1, on which claim 5 and 6 depend.

Applicants, therefore, solicit withdrawal of the imposed rejection of claims 5 and 6 under 35 U.S.C. § 103 for obviousness predicated upon Zhang et al. in view of Shiroishi et al. and Malhotra et al.

Claims 1, 2 and 7 through 9 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Okuyama et al.

In the statement of the rejection the Examiner referred to various portions of the patent text and relied heavily upon Table 1 asserting the disclosure of a structure wherein the second magnetic layer would exhibit a higher M_s than the first magnetic layer. This rejection is traversed.

Initially, Applicants again note that claims 7 through 9 have been cancelled and the limitations of claim 2 incorporated into claim 1. The Examiner addressed claim 2 in the first full paragraph of page 8 of the November 16, 2004 Office Action, relying heavily upon a perceived overlap in the amount of cobalt for the first and second magnetic layers. The Examiner then concluded there is sufficient guidance, given Table 1, to control the disclosed properties to achieve the limitations previously in claim 2, now in claim 1, i.e., that the first magnetic layer has a higher chromium content than the second magnetic layer and the second magnetic layer has a higher cobalt content than the first magnetic layer. Applicants disagree.

As discussed during the telephonic interview of December 2, 2004, notwithstanding the overlap, the guidance offered by Okuyama et al. point in a **direction opposite to that claimed**. Specifically, in Table 1, the magnetic layer with a higher Ms has a **lower** cobalt content, not a **higher** cobalt content as required by claim 1. Thus, as a **factual matter**, Okuyama et al. do **not** disclose a magnetic recording medium identically corresponding to that defined in claim 1 (which now contains the limitations previously in claim 2). Accordingly, the rejection under 35 U.S.C. § 102 cannot stand. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Going one step further, one having ordinary skill in the art would **not** have been **realistically motivated** to operate within the teachings of Okuyama et al. to arrive at the claimed invention. This is because, as previously pointed out, Okuyama et al. **teach away** from the claimed invention comprising first and second magnetic layers, wherein the second magnetic layer has a higher cobalt content and a higher Ms than the underlying first magnetic layer. This **teaching away** from the claimed invention constitutes evidence of **nonobviousness**. *In re Bell*, 991 F.2d 781, 26 USPQ2d

1529 (Fed. Cir. 1993); Specialty Composites v. Cabot Corp., 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); In re Marshall, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

Based upon the foregoing Applicants submit that the imposed rejection of claims 1, 2 and 7 through 9 under 35 U.S.C. § 102 for lack of novelty as evidenced by Okuyama et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 5 and 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Malhotra et al.

This rejection is traversed. Specifically, claims 5 and 6 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Okuyama et al. The additional reference to Malhotra et al. does not cure the previously argued deficiencies of Okuyama et al. As previously pointed out, Okuyama et al. **teach away** from the claimed invention, thereby evincing the **nonobviousness** of the claimed subject matter as a whole. *In re Bell, supra; Specialty Composites v. Cabot Corp., supra; In re Hedges, supra; In re Marshall, supra.*

Applicants, therefore, submit that the imposed rejection of claims 5 and 6 under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Malhotra et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 1 and 7 through 9 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Shiroishi et al.

This rejection is traversed.

As previously argued, Okuyama et al. **teach away** from a structure comprising first and second magnetic layers, wherein the second magnetic layer has a higher Ms and a higher cobalt content than the underlying first magnetic layer. This deficiency is not cured by Shiroishi et al. Applicants note again that claims 7 through 9 have been cancelled and that the limitations of claim 2 have been incorporated into claim 1.

Based upon the foregoing Applicants submit that the imposed rejection of claims 1 and 7 through 9 under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Shiroishi et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 2 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Shiroishi et al. and Yamashita et al.

This rejection is traversed.

Initially, Applicants will treat this rejection as though applied against claim 1, since the limitations of claim 2 have been incorporated into claim 1. As previously argued, the primary reference to Okuyama et al. **teaches away** from a structure comprising first and second magnetic layers, wherein the upper second magnetic layer has a higher Ms and a higher cobalt content than the underlying first magnetic layer. The additional references to Shiroishi et al. and Yamashita et al. do not cure the argued deficiencies of Okuyama et al. Simply put, the teaching by Okuyama et al. against the claimed invention constitutes a potent indicium of **nonobviousness**. *In re Bell, supra*; *Specialty Composites v. Cabot Corp., supra*; *In re Hedges, supra*; *In re Marshall, supra*.

Applicants, therefore, submit that one having ordinary skill in the art would not have found the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103, particularly

in view of the potent indicium of **nonobviousness** in that the primary reference to Okuyama et al. **teaches away** from the claimed invention.

Applicants, therefore, submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Shiroishi et al. and Yamashita et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 5 and 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Shiroishi et al. and Malhotra et al.

This rejection is traversed. Specifically, claims 5 and 6 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 based upon Okuyama et al. and, based upon Okuyama et al. in view of Shiroishi et al. The additional reference to Malhotra et al. does not cure the argued deficiencies of Okuyama et al. or the argued deficiencies in the attempted combination of Okuyama et al. in view of Shiroishi et al. Again, Applicants stress that Okuyama et al. **teach away** from forming a structure comprising first and second magnetic layers, wherein the upper second magnetic layer has a higher Ms and a higher cobalt content than the underlying first magnetic layer. Such a teaching away from the claimed invention constitutes a potent indicium of **nonobviousness**. *In re Bell, supra; In re Hedges, supra; In re Marshall, supra.*


Applicants, therefore, submit that the imposed rejection of claims 5 and 6 under 35 U.S.C. § 103 for obviousness predicated upon Okuyama et al. in view of Shiroishi et al. and Malhotra et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Applicants acknowledge, with appreciation, the Examiner's indication that claims 3 and 4 contain allowable subject matter. Applicants again acknowledge, with appreciation, the Examiner's courtesy and professionalism in conducting the telephonic interview on December 2, 2004, during which the Examiner agreed that the present Amendment would place the Application in condition for allowance. Accordingly, and for the reasons expressed *supra*, Applicants submit that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:bjs:ntb/lrd
Facsimile: 202.756.8087
Date: December 9, 2004

**Please recognize our Customer No. 20277
as our correspondence address.**